



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/551,252 | 04/18/2000 | Adolf Brodbeck | (K) 53 928 | 1754 |

7590 10/03/2007
M Robert Kestenbaum
11011 Bermuda Dunes NE
Albuquerque, NM 87111

| |
|----------|
| EXAMINER |
|----------|

DEXTER, CLARK F

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3724

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/551,252

Applicant(s)

BRODBECK ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,20-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2007 has been entered.

Claim Rejections - 35 USC § 112, 1st paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18, 39 and 40 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As stated in the previous Office actions, the operator of the ejector is not clear, particularly as to how it cooperates with the cutter and how it ejects a workpiece. More specifically:

- In paragraph 0018, a description is provided for a guide rail 16, a slide 17, and a threaded spindle 26 (not shown). However, the threaded spindle 26 is not shown, and the “corresponding guide element” which engages the threaded spindle is not shown and not sufficiently described. Thus, the connection between the slide 17 and the threaded spindle 16 is unclear, and thus it is not clear how the slide 17 is moved on or with respect to the guide rail 16.
- In Figure 1, elements are shown as being connected to the guide rail 16; specifically, undriven cutting unit 30 is connected to the guide rail 16, fixed cutting unit 53 is connected to guide rail 16, and driven cutting unit 35 is connected to guide rail 16. However, it is not clear as to how the ejector 21 is connected to the guide rail 16. Further, it is not clear how the cutting units and the ejector are independently moved/positioned along the guide rail 16. For example, it is not clear how the ejector 21 is moved with respect to the counter-holder 13. If the ejector is supported for such movement on the guide rail 16, it is not clear how the ejector 21 can move from the initial position 23 to the ejector position 24 without interference (i.e., running into) at least the cutting units 30 and 53.
- Further, it is not clear whether the cutting units 30, 53 and 35 and the ejector 21 are each connected to the threaded spindle for movement along the guide rail 16. And if so, it is not clear how they are separately controllable and/or positionable to attain the described cutting

Art Unit: 3724

arrangement(s) to produce different length tubes, particularly as now claimed in claim 39, lines 10-11.

- Additionally, the structure of the ejector 21 is not clear. It is not clear whether the ejector 21 and the cutting unit 35 are connected together as a single unit or whether they are separate, independently movable units. If the ejector 21 is not connected to the cutting unit 35, then it is not clear how or even if it is connected to the guide rail 16 and/or the threaded spindle 26 (not shown). Also, the structure of the ejector is not clearly disclosed. For example, as stated above, groove 42 as shown in Figure 1 appears to indicate a protruding structure that is on the left side of what appears to be a groove or recess, indicated by numeral 41. Also, it is not clear as to what movable bolt 39 is connected and how it is arranged.

The above list of questions, which is not necessarily an exhaustive list, cover many of the questions raised by the present disclosure. As has been stated, it remains unclear as to what is the specific structure to perform the functions attributed to the present invention.

4. Claims 18, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for a slide carrying "an ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a seating of said ejector sleeve" as now set forth in claim 39. In particular, it is not clear as to what disclosed structure the terms "driver element" and "seating" refer.

Claimed Subject Matter With Respect to Prior Art

5. Claims 18, 39 and 40 are considered to read over the prior art of record because the prior art or record does not teach or suggest the claimed combination of features including "a slide carrying the at least one cutting tool and ejector sleeve, having a driver element extendable in a direction toward the counter-holder and engaging a seating of said ejector sleeve" as now claimed. However, these claims **cannot** be considered to be "allowable" at this time due to the rejection(s) under 35 U.S.C. 112, 1st paragraph set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

Response to Arguments

6. Applicant's arguments filed June 22, 2007 have been fully considered but they are not persuasive for at least the reasons previously presented.

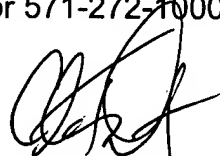
Remarks

7. Applicant is urged to contact the Examiner to discuss ways to expedite prosecution of the present application..

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Clark F. Dexter
Primary Examiner
Art Unit 3724